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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,604	06/23/2003	Ross K. Hill	CANATXX6:CIP	8916
21897	7590	09/21/2007		
THE MATTHEWS FIRM 2000 BERING DRIVE SUITE 700 HOUSTON, TX 77057			EXAMINER BORISSOV, IGOR N	
			ART UNIT 3628	PAPER NUMBER
			MAIL DATE 09/21/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/601,604

**Applicant(s)**

HILL ET AL.

**Examiner**

Igor N. Borissov

**Art Unit**

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Response to Amendment***

Amendment received on /2007 is acknowledged and entered. Claims 7-13 and 15-41 have been canceled. Claims 1-6 and 14 are currently pending in the application.

Applicant's election with traverse of claims 1-6 and 14 in the reply filed on 06/14/2007 is acknowledged. The traversal is on the ground(s) that each of the separate inventions relate to methods and systems for short term gas storage for gas trading.

This is not found persuasive because the subcombination B does not require particulars of subcombination A, such as: "*obtaining storage rights to at least a portion of one or more shallow depth underground salt formation storage facilities*", and "*making short term trades related to gas*".

Therefore, the requirement is still deemed proper and is therefore made FINAL. Claims 7-13 and 15-41 are withdrawn from consideration.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-6 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kennelley et al. (US 6,298,671 B1) in view of Bishop (US 5,129,759).**

Claims 1 and 14. Kennelley et al. teaches a method and system for storing natural gas in subterranean formation and delivering the gas to a marketplace, comprising:

obtaining storage rights to at least a portion of one or more shallow depth underground formation storage facilities operating at pressures averaging 20 to 80 bars (250 psig to about 10,000 psig; employing the subterranean formation 44 indicates obtaining necessary rights for conducting said operations) (C. 4, L. 11-17; C.1, L. 45-46);

making short term trades related to gas (the marketplace suggests trading gas) and

selectively utilizing said one or more shallow depth underground salt formation storage facilities by receiving gas into or providing gas out of said one or more shallow depth underground salt formation storage facilities (C. 4, L. 55-56). Information as to "*short term*" per se, the fact whether the trade is a short term or not cannot affect the method step recited. Therefore, said information is given no patentable weight. MPEP 2106 (II) (C) states: "Language that suggests or makes optional but does not require steps to be performed or does not limit a Claim to a particular structure does not limit the scope of a Claim or Claim limitation."

Furthermore, it is old and well known to conduct short terms trades on commodities. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kennelley et al. to include that said marketplace includes conducting short trade, because it would advantageously provide for various market conditions. Furthermore, so as this is a case where the improvements are no more than the predictable use of prior art elements according to their established functions, no further analysis for "motivation to combine" is required by the Examiner. *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396.

While Kennelley et al. teaches storing gas in the subterranean formation, Kennelley et al. does not specifically teach that said subterranean formation includes a salt formation.

Bishop teaches a method and system for storing natural gas in subterranean formation, wherein said formation is a salt formation (Abstract).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kennelley et al. to include that said subterranean formation includes a salt formation, as disclosed in Bishop, because it would advantageously allow to utilize subterranean formation of various types, thereby enhance the versatility of the system. Furthermore, so as this is a case where the improvements are no more than the predictable use of prior art elements according to their established functions, no further analysis for "motivation to combine" is required by the Examiner. *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396.

Claims 2-6. The combination of Kennelley et al. and Bishop teach method recited in claims 2-6. Information as to "short term is less than 24 hours", or "short term is less than 12 hours", or "short term is less than 6 hours", or "short term is less than one hour", or "short term is less than thirty minutes" - same reasoning as applied to claim 1.

#### **Examiner's Note**

Examiner has cited particular columns and line numbers or figures in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

### ***Conclusion***


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

IB

09/16/2007



IGOR N. BORISSOV  
PRIMARY EXAMINER